

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 09/809,494 Confirmation No.: 5659
Applicant : Alexandra KEENE
Filed : March 15, 2001
Title : SYSTEM AND METHOD FOR CHECK EXCEPTION ITEM NOTIFICATION
TC/Art Unit : 3624
Examiner: : Richard C. Weisberger
Docket No. J72167.000230 (formerly 72167.000230)
Customer No. : 70813

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Commissioner for Patents
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicants hereby request a pre-appeal brief conference simultaneously with a Notice of Appeal in the above-referenced case.

This application is appropriate for a pre-appeal brief conference. A brief history of this application follows. This application was filed on March 15, 2001. On February 22, 2002 the USPTO granted a petition to make this application special, thereby entitling the application to accelerated examination. On April 1, 2002, the Examiner mailed a request for information, not examining any of pending claims 1-26 on the merits. After the applicants' response to this request on October 1, 2002, the USPTO mailed a restriction requirement on February 11, 2003. On April 15, 2003, Applicant elected to pursue claims 1-20 for examination. On July 15, 2003, the USPTO issued another restriction requirement, revising the previous restriction requirement. Finally, on March 16, 2004, three years after the filing of this application entitled to accelerated examination, the Examiner issued a first non-final Office Action on the merits, rejecting elected claims 1-10 under 35 U.S.C. 101, 35 U.S.C 112, and over 35 U.S.C. 103 generally over all of

“Applicant’s admissions of prior art” without addressing the limitations of each claim. On July 16, 2004, Applicant responded to the first non-final Office Action. On November 2, 2004, the Examiner responding with another request for information under 37 CFR 1.105. On February 2, 2005, Applicant fully responded to this request for information. On March 9, 2006, the Examiner responded with a non-final Office Action on the merits, rejecting claims 1-10 under 35 U.S.C. 103. On August 4, 2006, Applicant responded by amending the claims and arguing against the rejection. After requiring correction of informalities, the USPTO issued a final rejection in error on December 12, 2007. This final rejection was erroneous, as it related to an entirely different case and was wholly irrelevant to the pending claims. Attempts to contact the Examiner by telephone to correct this error were unsuccessful. Thus, Applicant filed a response on March 4, 2008, asking for a new Office Action, relevant to the pending case. In response, the Examiner sent a new final rejection on April 7, 2008. Applicants responded with arguments on May 13, 2008, and received an Advisory Action on June 11, 2008. Thus, without filing of a single RCE, this application, entitled to accelerated Examination, has been pending for over seven years.

The current rejection fails to properly address each and every claim limitation, and fails to articulate a proper statement of motivation. In sum, a *prima facie* case of obviousness is not set forth in the Office Action dated April 7, 2008. Accordingly, rather than proceeding with an expensive appeal, Applicants respectfully request that the Office, following consideration of the remarks below, issue a Panel Decision allowing the application based on existing claims and closing the prosecution record. If the Panel declines to issue such a finding, then Applicants request that the Office either issue a proper office action stating a thoughtful basis for rejection or allow this application to proceed to appeal.

Claims 1-10 have been rejected under 35 U.S.C. § 103 over Positive Pay in view of U.S. Patent Publication 2001/0037315. This rejection is flawed at least because the Office Action fails to address each and every claim limitation.

With respect to independent claims 1 and 10, the combination of Positive Pay and Saliba fails disclose the claimed features. In summary, the Office Action fails to establish a *prima facie* case of obviousness. Specifically, before considering what would be obvious to one of ordinary skill in the art at the time of the invention, the art must teach or suggest the claim limitations. See MPEP §2143. Positive pay fails to disclose “receiving a presentment check file, said presentment check file including presentment information related to checks presented to a payor financial institution for payment” as required by claim 1. Specifically, in Positive Pay, each presented check is evaluated and compared to an issue file on a check-by-check basis. **No presentment file is implemented.** Claim 1 requires that a presentment file be received that is **related to multiple checks** for payment. Thus, based on this clause, **at least two features of claim 1 are absent from Positive Pay.** First, Positive Pay fails to disclose reception of a presentment file. Instead, in Positive Pay, the system merely receives the check or an image of the check itself. Secondly, in Positive Pay, even if the Examiner were to interpret the reference to consider the check itself as a presentment file, the presentment file would not relate to multiple checks presented as required by claims 1 and 10. Although the Advisory Action states on page 2, that the “claims read on a single check file comprising a single check”, this statement simply cannot be substantiated. “Checks” cannot correctly be interpreted as a “single check”.

Additionally, Positive Pay fails to disclose a third feature of “comparing said presentment check file with said payor check file thereby producing at least one exception item” as required by claim 1. As set forth above, Positive Pay compares a payor check file with each check presented on a check-by-check basis. Positive Pay does not disclose a presentment check file

which is compared with a payor check file to produce at least one exception item. Further, as acknowledged in the Office Action, the Positive Pay reference fails to disclose a fourth feature of claim 1, which includes sending said exception client an e-mail notifying said exception client of said at least one exception item.

With respect to claim 10, Positive Pay further fails to disclose generating a Web file, said Web file including an image relating to said exception item and sending said exception client an e-mail notifying said exception client of said at least one exception item. Positive Pay further fails to disclose generating an address for said Web file, wherein said e-mail address includes a hyperlink to said address.

Saliba fails to obviate the deficiencies of Positive Pay as set forth above. In order to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970); *In re Edward S. Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994). Thus, because the references do not include each and every feature of claims 1 and 10, a *prima facie* case of obviousness has not been established. Claims 2-9 depend from claim 1 and include further distinctive features not disclosed in the applied references. Thus, claims 2-9 define over the art of record for at least the reasons set forth above in relation to claim 1.

Applicant respectfully submits that the Examiner improperly assumes that the combination asserted in claims 1 and 10 would be desired. The PTO has the burden to establish that the prior art taken as a whole suggests the desirability of the combination. Rather than evaluating any suggestion in the reference, the Examiner himself assumes the combination

would have been obvious by asserting that automation is “well known”. However, the Examiner fails to explain why the art would suggest an email notification specifically for a check exception item. Thus, applicant submits that the Examiner’s assumption is improper.

As a result, the Examiner’s statement that Positive Pay “can benefit” from Saliba does not constitute specific motivation or suggestion for the combination. Rather, the inquiry is whether the prior art provides specific motivation to select the second reference and combine it with the first. The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007). Therefore, applicants respectfully submit that the combination of Positive Pay and Saliba would not have been obvious to one of ordinary skill in the art at the time of the invention.

The Office Action has failed to set forth a *prima facie* case of obviousness for the claims. Thus, an appeal on the current rejections will certainly succeed, but the time and expense in preparing an appeal brief on these issue should not be borne by Applicants when the grounds are improper. Additionally, Applicants deserve to finally receive a notice of allowance or a proper, fully-articulated rejection on the best art the Examiner can locate, so that Applicants can work with the PTO to bring this meritorious application to allowance without further delay.

Respectfully submitted,

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